

REMARKS1. Amendments to the Specification

To comport with the requirements of 35 U.S.C. § 202(c)(6), the written specification has been amended. Specifically, the specification has been amended to state that the U.S. Government has a paid-up license in this invention and the right in limited circumstances to require the patent owner to license others on reasonable terms as provided for by the terms of N66001-98-1-8914 awarded by the Defense Advanced Research Projects Agency (DARPA). No new matter has been introduced by the amendments.

2. Amendments to the Claims

Applicants note with appreciation the finding of allowable subject matter recited in claims 81, 82, 88, 89, 94, and 95. Applicants choose, however, to proceed with prosecution of the remaining claims.

a. Rejections under 35 USC § 102(b)

In the Office action, claims 77, 83, and 90 were rejected pursuant to 35 USC section 102(b) as allegedly being anticipated by Fukui et al. (U.S. Pat. No. 4,909,151) [hereinafter Fukui]. To summarize the standard, rejections under section 102 are proper only when one prior art reference discloses every feature of the claim so that there is no physical difference between the reference and the claimed invention. See In re Marshall, 198 USPQ 344 (CCPA 1978).

i. Claim 77

Claim 77 has been amended to define a method of separating a template extending in a first plane from a substrate extending in a second plane that includes, *inter alia*, applying a first force to form an oblique angle between the first plane and the second plane; and applying a second force differing from the first force to increase a distance between the template and the substrate so that the template is spaced-apart from the substrate, with the first force and the second force being greater than zero.

Applicants advocate this method to facilitate separation of the template from the substrate. Specifically, Applicants' claimed invention minimizes, if not prevents, "shearing or destruction of desired features from the substrate" when the template is separated from the substrate. (See ¶ [00032]). To that end, during separation of the template from the substrate, "the template is 'peeled' and 'pulled' from the substrate" such that the features of the substrate are not destroyed. (See ¶ [00023]).

Fukui does not teach of separating a template from a substrate utilizing multiple forces of differing magnitudes. This results from Fukui failing to recognize the problem Applicants sought to overcome. Applicants sought to overcome the shearing or destruction of features formed on the substrate after separation of the template from the substrate. Rather Fukui teaches of separating an ink remover from a printing plate with a "curvature of the ink remover 9 [being] increased" (see column 3, lines 28-29) wherein, it is inherent from Fig. 1D that to induce

such a curvature of the ink remover, a force is applied to the ink remover. However, Fukui is completely silent with respect to applying forces having differing magnitudes to the printing plate to separate the ink remover from the printing plate, with the multiple forces being greater than zero. Therefore, Applicants respectfully contend that Fukui does not anticipate claim 77, as amended.

ii. Claim 83

Claim 83 has been amended to define a method of separating a template from a substrate, with a first distance and a second distance defined therebetween, with the first distance being defined opposite to the second distance, that includes, *inter alia*, applying a first force to increase a first spacing between the substrate and the template so that a rate of change of the first distance is at a higher rate than a rate of change of the second distance; and applying a second force differing from the first force to increase a second spacing between the substrate and the template so that a rate of change of the first distance and the second distance are substantially uniform, with the first force and the second force being greater than zero. Applicants contend that the argument set forth above with respect to claim 77 applies with equal weight here and that claim 83, as amended, defines an invention suitable for patent protection.

iii. Claim 90

Claim 90 has been amended to define a method of separating a template extending in a first plane from an imprinting layer extending in a second plane, that includes, *inter alia*, applying a first force to form an oblique angle

between the first plane and the second plane to cause a wedge between the template and the imprinting layer at one end of a template-imprinting layer interface; and applying a second force differing from the first force to increase a distance between the template and the imprinting layer so that the template is spaced-apart from the imprinting layer, with the first force and the second force being greater than zero. Applicants contend that the argument set forth above with respect to claim 77 applies with equal weight here and that claim 90, as amended, defines an invention suitable for patent protection.

b. Obviousness

Implicit in any rejection under section 102 is an inchoate rejection under Section 103(a). Therefore, Applicants address any inchoate obvious rejections, as well.

As mentioned above, Fukui is completely silent with respect to applying forces having differing magnitudes to the printing plate to remove the ink remover from the printing plate, with the multiple forces being greater than zero. Rather, as mentioned above, Fukui is merely directed to separating an ink remover from a printing plate with a "curvature of the ink remove 9 [being] increased" (see column 3, lines 28-29) to separate the ink remover from the printing plate. As a result, Fukui does not recognize Applicants' problem and, therefore, there is no suggestion to modify Fukui to include Applicants' claimed invention. See *In re Sponnoble*, 160 USPQ 237 (CCPA 1969) (finding that is well established that an invention having an otherwise obvious structure is subject to patent protection if it

overcomes a known problem, the source of which the art had not previously recognized), see also, In re Nomiya, 184 USPQ 607, 612 (CCPA 1975) (holding that where the prior art fails to recognize the problem at all, the claimed invention may be deemed patentable). Based upon the foregoing, Applicants respectfully contend that a *prima facie* case of obviousness is not present with respect to claims 77, 83 and 90.

3. Dependent Claims

Considering that the dependent claims include all of the features of the independent claims from which they depend, these claims are patentable to the extent that the independent claims are patentable. Therefore, Applicants respectfully contend that the dependent claims define methods suitable for patent protection.

Applicants respectfully request examination of the amended claims. A notice of allowance is earnestly solicited.

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